IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number	: 09/883,300	Confirmation No.:	9721
Applicant	: Glen Boysko *et al*		
Filed	: June 19, 2001		
Title	: Method and system for security and user account integration by reporting systems with remote repositories		
TC/Art Unit	: 2155		
Examiner:	: Thu Ha Nguyen		
Docket No.	: 53470.003028		
Customer No.	: **21967**		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed over four years ago on June 19, 2001. Applicants' initial claims were rejected based on section 102 or section 103. In an effort to streamline prosecution, applicants amended independent claims 1, 8 and 15 to further clarify important distinctions over the primary reference and the proposed combination. A final rejection has now been entered against all claims on the combination under section 103.

Despite clearly indicating the deficiencies in the proposed motivation to combine in the first Office Action, the Office continues to misapply is obligation to provide motivation to combine references.

Specifically, claims 1-20 are presently rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,654,891 to Borsato *et al* ("Borsato") in view of U.S. Patent No. 6,453,353 to Win *et al* ("Win"). The Office Action acknowledges that Borsato does not disclose all the limitations as recited in claims. In particular, the Office Action admits that Borsato does not disclose wherein the user is associated with a group of users wherein group information from the remote repository is imported. The Office Action alleges that Win teaches these deficiencies and somehow concludes that it would have been obvious to combine Borsato and Win because it was "conventionally employed."

The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

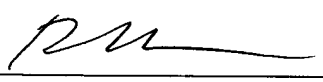
In the present case, the Office Action's sole justification for modifying Borsato has absolutely nothing to do with the deficiencies of Borsato. To properly modify Borsato to correct for these deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Borsato. Any such motivation is

completely lacking. Therefore, this is a clear example of improper hindsight.

The mere fact that the techniques of Winn may be conventionally employed in some contexts, does not mean that one of ordinary skill in the art would have recognized a need to modify Borsato and then identified the technique of Winn to make the modification. The Office has the burden to show a suggestion or motivation found somewhere in the prior art regarding the ***desirability*** of the modification ***of Borsato***. *See* M.P.E.P § 2143.01*; see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Thus, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by MicroStrategy when the grounds is so clearly improper.

Respectfully submitted,



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